REMARKS

In the November 3, 2004 Office Action, the Examiner:

- Rejected claims 2 and 18 due to informalities;
- Rejected claims 20 and 21 under 35 U.S.C. 112, second paragraph, as being indefinite;
- Rejected claims 16-22 under 35 U.S.C. 103(a) as unpatentable over King et al. ("*King*", U.S. Pat. No. 5,812,572) in view of Stephenson ("*Stephenson*", U.S. App. No. 2002/0027688 A1).
- Provisionally rejected claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 47-53 respectively of copending application 10/266,869;
- Provisionally rejected claims 8-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 69, 70 and 32-37 respectively of copending application 10/266,869; and
- Provisionally rejected claims 16-22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 71-77 respectively of copending application 10/266,869.

Applicants have amended claims 2, 16, 18, 20 and 21. Applicants have also added new claims 23-29. Accordingly, the pending claims are 1-29, with claims 1, 8, 16 and 23 being independent.

Claim Objections

The Examiner has objected to claims 2 and 18 as the phrase "from analog and digital" should read "from analog to digital." Claims 2 and 18 have been amended to correct this typographical error.

Claim Rejections - 35 U.S.C. § 112

Claims 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner states that there is insufficient antecedent basis for the limitation "the operation disable circuitry" in claims 20 and 21.

Claims 20 and 21 have been amended to depend from claim 17. Accordingly, both of these claims now have sufficient antecedent bases for "the operation disable circuitry" limitation. Accordingly, it is respectfully submitted that the Examiner's 35 U.S.C. 112 rejections have been addressed.

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected claims 16-22 under 35 U.S.C. 103(a) as unpatentable over *King* in view of *Stephenson*. To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.[1] This set of rejected claims contain one independent claim, namely claim 16.

Independent claim 16 has been amended to include the limitation of an interface for allowing a host to read from host-specified locations within the memory, including a memory location corresponding to the alarm flag. In other words, the host device can read from specific locations within the memory of the optoelectronic transceiver without having to read an entire diagnostics file from the memory. This has many advantages, including speed of data access, reduction in bandwidth used between the optoelectronic transceiver and the host device, improved efficiency, reduced load and wear on the memory, etc.

Unlike the present invention, the host computer 90 disclosed by *King* is only able to interrogate or communicate with the microcontroller 50 and not with the PROM, RAM or EEPROM.[2] Accordingly, *King* does not disclose, teach or suggest a host device that can read from host specified locations within a memory. *Stephenson* also does not disclose, teach or suggest a memory interface for allowing a host to read from host specified locations within the memory. For this reason alone, independent claim 16, and its dependant claims 17-22, cannot be unpatentable over *King* in view of *Stephenson*, as these references do not teach or suggest all of the claim limitations.

Double Patenting

Under the judicially created doctrine of obviousness-type double patenting, the Examiner has provisionally rejected claims 1-7 as being unpatentable over claims 47-53 respectively; claims 8-15 as being unpatentable over claims 32-37 and 69, 70 respectively; and claims 16-22 as being unpatentable over claims 71-77 respectively, of copending application 10/266,869.

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1 *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

2 *See King* col. 16, lines 58-67, and Figure 1.

Pursuant to 37 CFR 1.321(c), Applicants hereby submit a terminal disclaimer to overcome these provisional rejections.

New Claims

Applicants have added new claims 23-29. This set of new claims contain one independent claim, namely claim 23. These new claims are similar to original claims 1-7, and contain the same allowable subject matter identified by the Examiner. For example, the Examiner states that the cited references "do not suggest comparison logic for comparing the digital values corresponding to operating conditions of the device with setpoint values in order to specifically generate flag values, wherein the flag values are specifically stored in predefined locations within the memory during operation of the optoelectronic device . . ." The cited art also does not suggest "an interface for allowing a host to read from a host-specified locations within the memory, including the predefined location storing the alarm flag." Accordingly, neither *King* nor *Stephenson* disclose, teach or suggest all of the limitations of independent claim 23 or its dependant claims 24-29.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is now in a condition for allowance. However, should the Examiner believe that the claims are not in condition for allowance, the Applicant encourages the Examiner to call the undersigned attorney at 650-849-7501 to set up an interview.

If there are any fees or credits due in connection with the filing of this Amendment, including any fees required for an Extension of Time under 37 C.F.R. Section 1.136, authorization is given to charge any necessary fees to our Deposit Account No. 50-0310 (order No. 060900-0208-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

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